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EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/633,089

Applicant(s)

WALLACE ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 17 December 2001.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Le Roux (US 5,486,687).

Re claims 1-9 and 16-21, Le Roux discloses an electronic card that is removably insertable into a receptacle 30, which makes electrical contact with contacts 16 on the card; a first published card standard 10, which is a SD card; a second published card standard 18, which is an ISO 7816 standard (col. 3, lines 25-31; an electrical signal interface at the contacts 16, through which a security code can be accessed; wherein the first card 10 includes electronic functions and an electrical interface according to the second standard card that are distinct from electronic function and an electrical interface of the first card standard (see figs. 1-4; col. 3, line 7 through col. 6, line 2); the security code stored in the card 18 is accessible through the card contacts 12 according to the electrical interface of the second card standard (i.e., PCMCIA) while the card shape and contacts conform to the first card standard (i.e., credit card or memory card, etc.); the a first card 18 having a physical shape (i.e., credit card or memory card, etc.), arrangement of electrical contacts 16 and inherently an electrical interface through the contacts 16 according to a first published card standard; and a

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second card 10 having a physical shape (i.e., PCMCIA) and an arrangement of electrical contacts 16 according to the first card standard and an electrical interface through the contacts 12 according to a second published card standard (Figs. 1-3; col. 3, line 32 through col. 4, line 61).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Roux in view of Benezet (US 5,278,395). The teachings of Le Roux have been discussed above.

Re claims 10 and 14-15, Le Roux have been discussed above but fails to teach or fairly suggest the method of removing the first card from the receptacle then inserting the second card.

Benezet teaches the above limitation in fig. 2 and col. 7, line 11 through col. 8, line 15; wherein the first card 10 has to be inserted and removed before inserting the second card 6.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Benezet into the teachings of Le Roux in order to provide Le Roux with a more secure system, wherein the two cards are required to be inserted in a first and the second sequential order to operate the system. Furthermore, such modification would have provided Le Roux with a feasible system (i.e., only one receptacle is needed to accommodate two cards rather than to provide two dedicated receptacle with two separate processors). Accordingly, such modification would have been an obvious extension as taught by Le Roux for a more compact and feasible system, well within the ordinary skill in the art, and therefore an obvious expedient.

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6. Claims 11-13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Roux as modified by Benezet as applied to claim 10 above, and further in view of Iwasaki et al (US 6,002,605). The teachings of Le Roux as modified by Benezet have been discussed above.

Re claims 11, 12 and 24, Le Roux as modified by Benezet fails to teach or fairly suggest that the data inputted to the electronic device include audio data that is utilized by a sound system within the device to generate sounds, wherein the sounds include music.

Iwasaki et al teaches the above limitation in col. 16, lines 17-46.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Iwasaki et al into the teachings of Le Roux/Benezet in order to provide Le Roux/Benezet with a universal system, in which the operator has a greater flexibility in storing and for retrieving information in a plurality of formats (e.g., audio data, video data or digital code data, etc...), and thus providing a user friendly system. Accordingly, such modification would have been an obvious extension as taught by Le Roux/Benezet, well within the ordinary skill in the art, and therefore an obvious expedient.

Re claim 13, Le Roux/Benezet as modified by Iwasaki et al fails to teach or fairly suggest that the system including an audio unit for installation in a vehicle.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a conventional audio unit into the teachings of Le Roux/Benezet/Iwasaki et al in order to provide Le Roux/Benezet/Iwasaki et al with a more user-friendly system device wherein the operator would receive audio information/data that is pertinent to the operator. Therefore, such modification would have been an obvious extension as taught by Le Roux/Benezet/Iwasaki et al, well within the ordinary skill in the art, and therefore an obvious expedient.

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7. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki et al in view of Itou et al (US 6,010,066). The teachings of Iwasaki et al have been discussed above.

Re claims 22-23, Iwasaki et al discloses an electronic device an electronic system; a stored security code; at least one receptacle into which at least a non-volatile memory card is removably insertable, a circuit 56 connected to the at least one receptacle to receive a security code from a first memory card 11 inserted into the at least one receptacle; another circuit 51 connected to the at least on receptacle to receive data from a second memory card 21 inserted into the at least one receptacle (see figs. 15A-B & 17; col. 13, lines 41-61 and col. 14, lines 16-58).

Iwasaki et al fails to teach or fairly suggest the security code and data receiving circuit are connected with a single receptacle.

Itou et al teaches the above limitation with microprocessor, memory device, etc. are connected with a single receptacle 12 (fig. 3; col. 5, lines 22-42).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Itou et al into the teachings of Iwasaki et al in order to provide Iwasaki with a more compact system wherein only one single receptacle is required for connecting with the security code an data receiving circuit instead of separated receptacles, thus saving space and therefore, reducing the size of the system. Furthermore, such modification would have been an obvious extension as taught by Iwasaki et al, and therefore an obvious expedient.

#### ***Response to Arguments***

8. Applicant's arguments filed 17 December 2001 have been fully considered but they are not persuasive.

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9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a single card that mixes, from different standards, the physical shape, the electrical contact arrangement and the electrical signal interface (p. 3, 4<sup>th</sup> paragraph); mixing of features from different standards within one card (p. 3, 5<sup>th</sup> paragraph); require change in the electrical interface standard of the card (p. 4, 1<sup>st</sup> paragraph); and both of the memory card and credit card are connectable to the card reader connector (p. 4, 3<sup>rd</sup> paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. In response to the Applicant's argument with regard to "... the electrical signal interface is presented at the card contacts according to both of the first and second card standards, something not even remotely considered by Le Roux..." (p. 4, 2<sup>nd</sup> paragraph), the examiner respectfully requests the applicant to further review Le Roux, by giving its broadest reasonable interpretation, wherein the security code stored in the card 18 is accessible through the card contacts 12 according to the electrical interface of the second card standard (i.e., PCMCIA) while the card shape and contacts conform to the first card standard (i.e., credit card or memory card, etc.) (Figs. 1-3; col. 3, line 32 through col. 4, line 61). Therefore, the card 18 includes data stored therein of a security code that is accessible through the card contacts according to the electrical interface of the second card standard, and includes content data stored therein that is accessible through the card contacts 16 according to the electrical interface of the first card standard, wherein the security code is adapted for use in enabling utilization of the content data as taught by Le Roux meets the limitation of the claimed invention.

11. In response to the Applicant's argument with regard to "... Le Roux does not suggest the claimed second card..." (p. 4, 3<sup>rd</sup> paragraph), the examiner respectfully requests the applicant to further review Le Roux, by giving its broadest reasonable interpretation, wherein the a first card 18 having a physical shape

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(i.e., credit card or memory card, etc.), arrangement of electrical contacts 16 and inherently an electrical interface through the contacts 16 according to a first published card standard; and a second card 10 having a physical shape (i.e., PCMCIA) and an arrangement of electrical contacts 16 according to the first card standard and an electrical interface through the contacts 12 according to a second published card standard (Figs. 1-3; col. 3, line 32 through col. 4, line 61). Therefore, the first and second cards as taught Le Roux meets the limitation of the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references (p. 5, 5<sup>th</sup> paragraph), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Le Roux discloses a method of operating an electronic device comprising a security card and a memory card. The insertion of the security card will be requested if only a memory card is inserted in the reader (col. 4, line 35 through col. 5, line 28). However, Le Roux is silent with respect to remove the first card/security card from the receptacle then inserting the second card/memory card into the receptacle. The secondary reference to Benezet teaches the above limitation with the first card 10 has to be inserted and removed before inserting the second card 6 (fig. 2; col. 7, line 11 through col. 8, line 15). Accordingly, the claimed limitation, given its broadest reasonable interpretation, Le Roux in view of Benezet meets the claimed invention (see the above discussion and the Office Action, paper No. 5).

For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.



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***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-F 6:00-1:30 and Sat 6:00-11:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Uyen-Chau N. Le

July 17, 2002

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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